

REMARKS

Claims 2-7, 10-12, 14-16, 18, 20, 21, 23-28, and 35-68 were previously pending in this Application before entrance of the present Amendment. Claims 2, 4-6, 12, 14-16, 18, 20, 21, 23-25, 39-54, 61, 63, and 65 stand rejected by the Examiner, and claims 3, 7, 10, 11, 26-28, 35-38, 55-60, 62, 64, and 66-68 have been withdrawn from consideration by the Examiner at this time. By this Amendment, claims 2, 4-6, 14, 20-21, 39, and 41-42 have been amended, and claims 3, 7-11, 35-38, 55-60, 67, and 68 have been canceled. As a result, claims 2, 4-6, 12, 14-16, 18, 20-21, 23-25, 39-54, 61, 63, and 65 are pending in this case with claims 2, 4-6, 25-28, and 61-66 being independent claims. No new matter has been added to the Application by this Amendment. Applicant reserves the right to pursue subject matter canceled from the pending claims in a future application claiming priority to the present application. Applicant respectfully requests reconsideration of the amended claims in this case.

Each of the rejections levied by the Examiner in the outstanding Office Action is discussed in turn below.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner has rejected claims 2, 4-6, 12, 14-16, 18, 20-21, 23-25, 39-54, 61, 63, and 65 under 35 U.S.C. § 112, first paragraph, for lack of enablement. The Examiner maintains that “the specification, while being enabling for R2 to be alkyl or alkyloxyalkyl, and X to be an alkyl does not reasonably provide enablement for R2 to be any such as R4, -X-R4, -X-Y-R4 and X-R5 wherein X-Y, R4 and R5 have a variety of different definitions nor for X to have all the different substituents and variations.” Applicant disagrees. However, solely to facilitate the prosecution of the present application, Applicant has amended the pending claims, thus obviating the present rejection. Applicant respectfully submits that one of ordinary skill in the art could make and use the invention commensurate in scope with the amended claims. Accordingly, withdrawal of the rejection of claims 2, 4-6, 12, 14-16, 18, 20-21, 23-25, 39-54, 61, 63, and 65 under § 112 is respectfully requested.

Rejections under 35 U.S.C. § 103

The Examiner has rejected claims 2, 4-6, 12, 14-16, 18, 20-21, 23-25, 39-54, 61, 63, and 65 under 35 U.S.C. § 103(a) as being obvious over WO 2004/0587959, U.S. Patent 7,091,214, U.S. Patent 6,525,064, WO2005/076783, WO2005/051324, and WO2005/051317. The Examiner has cited these U.S. patents and published PCT application as prior art only under § 102(e). With respect to WO 2004/0587959, U.S. Patent 6,525,064, WO2005/076783, WO2005/051324, and WO2005/051317, Applicant submits herewith Declarations under 37 CFR § 1.132 evidencing that the inventions described in these patents and patent applications were not invented “by another” as required by § 102(e) to constitute prior art. WO 2004/0587959, U.S. Patent 6,525,064, WO2005/076783, WO2005/051324, and WO2005/051317 are not prior art under § 102(e), and therefore, these patents and applications are not prior art citable against the present Application under § 103.

With respect to U.S. Patent 7,091,214, which is prior art only under § 102(e), Applicant submits that the '214 patent is disqualified as prior art under 35 U.S.C. § 103(c). The subject matter of the '214 patent and the claimed invention of the present application were, at the time the claimed invention, was made owned by the same entity, 3M Innovative Properties Co., as evidenced by the Assignments recorded in each case at the USPTO.

Applicant respectfully requests that this rejection be removed.

Double Patenting Rejection

Claims 2, 4-6, 12, 14-16, 18, 20-21, 23-25, 39-54, 61, 63, and 65 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 of U.S. Patent 7,091,214, in view of U.S. Patent 6,525,064, WO2005/076783, WO 2005/051324, and WO 2005/051317. Applicant wishes to defer commenting on this rejection at this time.

Claims 2, 4-6, 12, 14-16, 18, 20-21, 23-25, 39-54, 61, 63, and 65 stand provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-6 of copending U.S. application, U.S.S.N. 11/275,553. Applicant wishes to defer commenting on this rejection until the claims of the present Application have been allowed.

Applicant believes no fee is due with this response. However, if a fee is due, please charge our Deposit Account No. 23/2825, under Docket No. C1271.70045US03, from which the undersigned is authorized to draw.

Dated: December 11, 2009

Respectfully submitted,

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